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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,099	05/31/2000	Nino Richard Vaghi	04480002CA	4453

7590 05/02/2002
ATTEN: SAMUAL W. NITRO
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EXAMINER

CHARLES, DEBRA F

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary

Application No.

09/584,099

Applicant(s)

VAGHI, NINO RICHARD

Examiner

Debra F. Charles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Claims 21-25 have been examined.

DETAILED ACTION

Priority

1. Acknowledgement is made of a claim for domestic priority under 35 U.S.C. 120 and/or 121.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 21-25 are rejected under the judicially created doctrine of double patenting over claims 1, 7, 14, 22, and 9 respectively of U. S. Patent No. 6249778 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

As per claim 21, claim 1 of U.S. Patent No. 6,249,778 B1 recites an electronic scale integrally formed within a flat-panel display, comprising:

a platform for supporting an item; and

a weighing unit mounted at least partially within a housing of said flat-panel display,

said weighing unit including ... a force transducer which outputs a weight signal indicative of a weight of said item when said item is placed on said platform.

Claim 1 of U.S. Patent No. 6,249,778 B1 differs since it further recites additional claim limitations including at least one support member in contact with said platform, at least a portion of said platform being exposed along an exterior surface of said housing; and

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a force transducer mounted within said housing at a position adjacent said support member, said support member impinging upon said . . . However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent No. 6,249,778 B1 by removing certain limitations directed to the elements that make up an apparatus resulting in a claim such as that of claim 21 since both claims actually perform the same function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

As per claim 22, claim 7 of U.S. Patent No. 6,249,778 B1 recites an electronic scale integrally formed within a housing of a printer, comprising:

a platform for supporting an item;

a weighing unit mounted at least partially within a housing of said printer, said weighing unit including a force transducer . . . which outputs a weight signal indicative of a weight of said item when said item is placed on said platform.

Claim 7 of U.S. Patent No. 6,249,778 B1 differs since it further recites additional claim limitations including mounted within said housing at a position underneath said

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platform, and two support members for supporting said platform, each of said two support members having a first end connected to said platform and a second end within an interior of said housing, said support members deflecting to allow said platform to impinge upon said However, it would have been obvious to a person of ordinary skill in the art to modify claim 7 of U.S. Patent No. 6,249,778 B1 by removing certain limitations directed to the elements that make up an apparatus resulting in a claim such as that of claim 22 since both claims actually perform the same function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

As per claim 23, claim 14 of U.S. Patent No. 6,249,778 B1 recites an electronic scale integrally formed within a CRT monitor, comprising:

a platform for supporting an item; and

a weighing unit mounted at least partially within a housing of said CRT monitor,

said weighing unit including

a force transducer . . . which outputs a weight signal indicative of a weight of said item when said item is placed on said platform.

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Claim 14 of U.S. Patent No. 6,249,778 B1 differs since it further recites additional claim limitations including at least one support member in contact with said platform, at least a portion of said platform being exposed along an exterior surface of said housing; and . . . mounted within said housing at a position adjacent said support member, said support member impinging upon said . . . to cause said force transducer to . . .

However, it would have been obvious to a person of ordinary skill in the art to modify claim 23 of U.S. Patent No. 6,249,778 B1 by removing certain limitations directed to the elements that make up an apparatus resulting in a claim such as that of claim 14 since both claims actually perform the same function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

As per claim 24, claim 22 of U.S. Patent No. 6,249,778 B1 recites an electronic scale integrally formed within a CPU unit of a personal computer, comprising:
a platform for supporting an item; and
a weighing unit mounted at least partially within a housing of said CPU unit, said weighing unit including
a force transducer . . . which outputs a weight signal indicative of a weight . . .

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Claim 22 of U.S. Patent No. 6,249,778 B1 differs since it further recites additional claim limitations including said personal computer and at least one support member in contact with said platform, at least a portion of said platform being exposed along an exterior surface of said housing; a force transducer mounted within said housing at a position adjacent said support member, said support member impinging upon said . . .

However, it would have been obvious to a person of ordinary skill in the art to modify claim 22 of U.S. Patent No. 6,249,778 B1 by removing certain limitations directed to the elements that make up an apparatus resulting in a claim such as that of claim 24 since both claims actually perform the same function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

As per claim 25, claim 9 of U.S. Patent No. 6,249,778 B1 recites a system for computing a postal or carrier rate, comprising:

a piece of office equipment selected from the group consisting of a flat-panel display unit, a CRT monitor, a CPU unit of a personal computer, and a printer, an electronic scale integrally formed within a housing of said piece of office equipment, said electronic scale including a platform for supporting an item and a weighing unit mounted at least partially within a housing,

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said weighing unit including

a force transducer . . . which outputs a weight signal indicative of a weight of said item when said item is placed on said platform; and
a processor for computing a postal or carrier rate for said item based on said weight signal.

Claim 9 of U.S. Patent No. 6,249,778 B1 differs since it further recites additional claim limitations including a piece of office equipment and mounted within said housing at a position adjacent said support member, said support member impinging upon said force transducer However, it would have been obvious to a person of ordinary skill in the art to modify claim 9 of U.S. Patent No. 6,249,778 B1 by removing certain limitations directed to the elements that make up an apparatus resulting in a claim such as that of claim 25 since both claims actually perform the same function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of

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the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

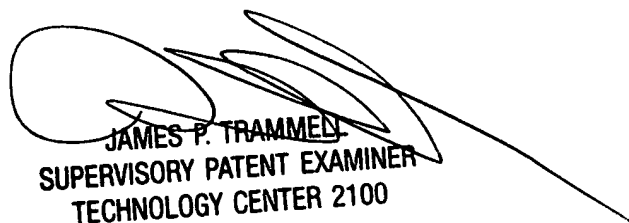
Debra F. Charles

Examiner

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dfc

April 25, 2002


JAMES P. TRAMMELL
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